I. Qualification of Radziewicz (US Patent No. 5,854,897) as prior art under 35USC §102(e)

In the final Office Action, all the independent claims 1, 19, 24, 29 and 33 are asserted by the Examiner as being anticipated by Radziewicz under 35USC §102(e). Moreover, the Examiner holds that Radziewicz and the present application claim the same invention, and therefore Applicants cannot remove Radziewicz from the prior art by filing the Affidavit under 37CFR §1.131. Applicants respectfully disagree.

First, Applicants respectfully disagree with the assertion of the Examiner that Radziewicz discloses the distinguishing feature of the present invention that "the additional content is determined based on the network server identifier (such as the IP address or URL of the network server)", as expressly recited in independent claims 1, 19 and 33. Applicants have reviewed Radziewicz carefully but cannot find support of such assertion anywhere throughout Radziewicz. In particular, in the paragraph (col. 7, lines 18-54) that the Examiner relies upon, Radziewicz teaches to determine which announcements are to be played based upon the IP address of the DTE 14 (see col. 7, lines 26 – 33), and also teaches to determine when a particular announcement is to be played based upon the IP address of the computer 12 (see col. 7, lines 20-26), Radziewicz, however, does NOT teach to determine which announcements are to be played based on the IP address of the computer 12. In other words, in Radziewicz, the announcement (not the time to play the announcement) is determined by the IP address of the DTE 14 (i.e., the identifier of the "client"), but not by the IP address of the computer 12. Therefore, the distinguishing feature that "the additional content is determined based on the network server identifier" recited in independent claims 1, 19 and 33 of the present application is not disclosed by Radziewicz in either the description or any of the claims of Radziewicz (no matter they are in means-plus-function language or not).

2

Secondly, Radziewicz does not disclose that a bridge server (NPS 16) receives from a client (DTE 14) a request targeting a network server (computer 12), marks up the same request, and returns the same request in a marked-up form to the client for re-submission, as recited in independent claims 24 and 29. It shall be noted that, in the present invention as defined in claims 24 and 29, there is only one request involved, i.e., the request targeting the network server (please note the definite article "the" repeatedly used in front of the term "request" in claims 24 and 29). In fact, after the request targeting the remote host computer 12 is received at the NSP 16 from the DTE 14 the request is routed to the remote host computer 12 and is never marked-up and/or returned to DTE 14 (see, e.g., col. 14, lines 20- col. 15, line 59, more specifically, col. 14, lines 20-33). When the connection path 20 is found to be idle, NSP 16 (or the announcement server 30) sends the announcement to DTE 14. It is clearly that this announcement sent to DTE 14 is not the request (or a marked-version thereof) targeting the remote host computer 12.

Moreover, in col. 12, lines 23-45 of Radziewich, which was cited by the Examiner in a previous Office Action dated December 18, 2003 to support his assertion that the claims 24 and 29 have been anticipated by Radziewicz, Applicants cannot find a teaching that the same request is marked up by the bridge server (i.e., announcement server 30), returned to the client (DTE 14) and resubmitted by the client. It is be noted that the announcement transmitted by the announcement server 30 to the DTE 30 is a retrieved content in response to a request targeting the announcement server 30, but not the request targeting the announcement server 30 itself. In addition, the announcement is also used as a request targeting the advertiser servers 12 identified by the URLs embedded in the announcement, but not a marked-up form of the request targeting the announcement server 30. In other words, there is no teaching or implication in Radziewicz that the same request (targeting to the same server) is marked-up by the bridge server, returned to

3

the client, and then re-submitted by the client, and there is no such limitations in the claims in Radziewicz either. Therefore, the present invention defined in independent claims 24 and 29 is not disclosed by Radziewicz in either the description or any of the claims of Radziewicz (no matter they are in means-plus-function language or not).

Thus, Applicants respectfully request Radziewicz to be disqualified as prior art under 35USC §102(e) since it does not claim the same invention as the present claims, and it was filed after the invention date of the present invention (see the Affidavit under 37CFR §1.131 filed by Applicants on March 12, 2001).

II. Rejections to independent claims 24 and 29 as being anticipated by Hudetz et al (US Patent No. 5,978,773)

Independent claims 24 and 29 are also rejected by the Examiner as being anticipated by Hudetz. Applicants respectfully traverse the rejection. In particular, Applicants respectfully submit that Hudetz does not disclose or imply that the same request from a client targeting a network server is marked-up by a bridge server, returned to the client, and then resubmitted by the client. Hudetz discloses a system in which a barcode ("UPC") is used to query the URL from a database, and then the retrieved URL is used to visit the targeted website. The client sends a first request targeting the database to retrieve the URL by the UPC, and then sends a second request targeting the website by the retrieved URL. Therefore, the URL is a retrieved content in response to the first request (targeting the database), but not a marked-up form of the first request. The retrieved URL is also used as a second and new request (targeting the website), which is not the first request (targeting the database). In the Office Action, the Examiner apparently interprets the request targeting the database for querying the URL by the UPC as a

4

request targeting the website identified by the retrieved URL, which the Applicants believe improper. Therefore, the present invention defined in claims 24 and 29 is not anticipated by Hudetz, and claims 24 and 29 are therefore patentable.

III. Rejections to independent claims 1, 19 and 33 as being obvious over combinations of Hertz (US Patent No. 5,754,938) and Vance (US Patent No. 5,878,219)

Independent claims 1, 19 and 33 are also rejected as being obvious over Hertz in view of Vance under 35USC §103(a). Applicants respectfully traverse the rejection.

In particular, neither Hertz nor Vance discloses that the additional content is determined by the network server identifier, as recited in claims 1, 19 and 33. In fact, Hertz only generally discloses that the advertising material (read as "additional content") is related to the user's request (see col. 39, lines 67), but does not teach that the advertising material is determined by the identifier of the network server (such as the IP address of the URL of the network server). Vance does not teach this feature either, since Vance only discloses use of extensions of a URL to identify the objects of the online service, but never teaches that a bridge server determines an additional content by the URL of a targeted server. In other words, Vance may contribute to Hertz only in that the identifier of a targeted server can be a URL of the targeted server, but cannot help Hertz to conclude that the URL of the targeted server can be used by the bridge server to determine the additional content. Therefore, independent claims 1, 19 and 33 are not obvious over the combination of Hertz and Vance, and are therefore patentable.

IV. Other cited patents: Rondeau (US Patent No. 5,850,433), Gabber (US Patent No. 5,961,593) and Van Hoff (US Patent No. 5,822,539)

None of these three cited patents discloses the distinguishing feature that the additional content is determined by the network server identifier as recited in independent claims 1, 19 and 33 or the features that the same request targeting a network server is marked-up by a bridge server, returned to the client and resubmitted by the client, as defined in independent claims 24 and 29. Therefore, the patentability of independent claims 1, 19, 24, 29 and 33 is not jeopardized by Rondeau, Gabber, Van Hoff or their combinations with Radziewicz, Hudetz, Hertz and Vance.

V. Dependent claims 2-4, 6-9, 11, 13-18, 21-23, 25, 30, 34-39 and 42-43

At least for the above reasons as to the patentability of independent claims 1, 19, 24, 29 and 33, all the dependent claims are also believed patentable. In particular, for the similar reasons as explained with respect to claims 24 and 29, the patentability of claims 13-16 and 23 is further strengthened as none of the cited patents discloses to mark up, by the bridge server, the request targeting the network server and return the marked-up request to the client for resubmission.

The applicants respectfully request reconsideration and allowance of claims in view of the above. The examiner is authorized to charge any shortages or credit any overpayments to our deposit account number 11-0223.

Respectfully submitted,

KAPLAN & GILMAN, L.L.P.
900 Route 9 North
Woodbridge, NJ 07095
Telephone (732) 634-7634

DATED: September 2, 2004

Jeffrey I. Kaplan
(Reg. No. 34,356)

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal service as first class mail, in a postage prepaid envelope, addressed to Mail Stop RCE, Commissioner For Patents, P. O. Box 1450, Alexandria, VA 22313-1450 on September 2, 2004.

Dated ___September 2, 2004___ Signed _____ Print Name ___Ute H. Wojtkowski___

RECEIVED

SEP 0 8 2004

Technology Center 2600